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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/930,944	08/17/2001	Ryouji Sugiura	520.40395X00	1547

20457 7590 11/20/2002

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EXAMINER

NGO, HUNG V

ART UNIT	PAPER NUMBER
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2831

DATE MAILED: 11/20/2002

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/930,944

Applicant(s)

Sugiura et al

Examiner

Hung V. Ngo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09-03-2002 and 09-06-2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above, claim(s) 2, 3, 16-19, 22, and 23 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-15 and 20 is/are allowed.
- 6) ☒ Claim(s) 1, 4-7, 21, and 24-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 21-27 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 21, lines 13-15, is not discussed in the specification. Any negative limitation or exclusionary proviso must have basis in the original disclosure See Ex parte Grasselli, 231 USPQ 393 (Bd. App. 1983)(MPEP 2173.05(i)). This limitation is not considered over the prior art in addressing the claims.

Claims 22-27 are included because of their dependency.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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2. Claims 1, 4, 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Maekawa.

Maekawa discloses an electronic device, comprising: a substrate (3) of insulating resin having at least a pair of interior terminal portions (5) for connection upon an upper surfaces thereof; an electronic element (6) mounted on the terminal portions on the upper surface of said substrate, having at least a pair of electrode terminals (1) thereof; a frame member (3) of insulating resin (col 4, line 55), bonded on the upper surface of said substrate, and having a cavity (8) formed for storing said electronic element therein; and a cover member (2) of insulating material, for hermetically sealing over the cavity of said frame member, in which said electronic element is stored, wherein electrodes (10) are formed at or in vicinity of positions of the terminals of said electronic element stored within said cavity, for electrically conducting said interior terminal portions for connection to an outside (re claim 1).

Re claim 4, wherein exterior terminals (11) are provided on a lower surface of said substrate.

Re claim 6, the limitations of "wherein said substrate, said frame member and said cover member are formed from plate-like members of metal clad laminate" have been considered, but does not result in a structural difference. The presence of process limitations in product claims, which product does not otherwise patentably distinguish over prior art, cannot impart patentability to that product. In re Stephens 145 USPQ 656 (CCPA 1965).

3. Claims 21, 24, 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Masashi et al (JP 10-163647).

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Mashashi et al discloses an electronic device, comprising: a substrate (2) of insulating resin having at least a pair of interior terminal portions (7) for connection upon an upper surfaces thereof; an electronic element (10) mounted on the terminal portions on the upper surface of said substrate, having at least a pair of electrode terminals ⁽¹¹⁾ thereof; a frame member (3) of insulating resin (abstract), bonded on the upper surface of said substrate, and having a cavity (5) formed for storing said electronic element therein; and a cover member (6) of insulating material (resin), for hermetically sealing over the cavity of said frame member, in which said electronic element is stored, wherein electrodes (11) are formed at or in vicinity of positions of the terminals of said electronic element stored within said cavity, for electrically conducting said interior terminal portions for connection to an outside (re claim 21), external terminals (9, 21)(re claim 24)

Re claim 26, the limitations of “wherein said substrate, said frame member and said cover member are formed from plate-like members of metal clad laminate” have been considered, but does not result in a structural difference. The presence of process limitations in product claims, which product does not otherwise patentably distinguish over prior art, cannot impart patentability to that product. In re Stephens 145 USPQ 656 (CCPA 1965).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daniels et al

Daniels et al disclose an electronic device (140), comprising: a substrate (111, 112) of insulating material having at least a pair of interior terminal portions for connection upon an upper surfaces thereof; an electronic element (121) mounted on the terminal portions on the upper surface of said substrate, having at least a pair of electrode terminals thereof (col 2, lines 55-58); a frame member (141) of insulating material, bonded on the upper surface of said substrate, and having a cavity formed for storing said electronic element therein; and a cover member (142) of insulating material, for hermetically sealing over the cavity of said frame member, in which said electronic element is stored, wherein electrodes are formed at or in vicinity of positions of the terminals of said electronic element stored within said cavity, for electrically conducting said interior terminal portions for connection to an outside (re claim 1).

Re claim 4, wherein exterior terminals (113) are provided on a lower surface of said substrate.

Re claim 6, the limitations of "wherein said substrate, said frame member and said cover member are formed from plate-like members of metal clad laminate" have been considered, but does not result in a structural difference. The presence of process limitations in product claims,

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which product does not otherwise patentably distinguish over prior art, cannot impart patentability to that product. In re Stephens 145 USPQ 656 (CCPA 1965).

Re claim 7, wherein said electronic element stored within said cavity is an optical element, and said cover member for sealing over said cavity is made of transparent material (col 2, lines 60-62).

The teaching as discussed above does not disclose the substrate and frame member made of resin (re claim 1), conductors made from layers of noble metal (re claim 5).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use resin for the substrate and frame member or to use noble metal for the conductor of of Daniels et al, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Masashi et al

The teaching as discussed above does not disclose conductors made from layers of noble metal (re claim 25).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use noble metal for the conductor of Masashi et al, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416

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Claims 21, 25, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over London et al.

London et al disclose an electronic device comprising: a substrate (10) of insulating material having at least a pair of interior terminal portions for connection upon an upper surfaces thereof; an electronic element (14) mounted on the terminal portions on the upper surface of said substrate, having at least a pair of electrode terminals thereof; a frame member (22) of insulating material, bonded on the upper surface of said substrate, and having a cavity formed for storing said electronic element therein; and a cover member (26) of insulating material, for hermetically sealing over the cavity of said frame member, in which said electronic element is stored, wherein electrodes (20) are formed at or in vicinity of positions of the terminals of said electronic element stored within said cavity, for electrically conducting said interior terminal portions for connection to an outside

The teaching as discussed above does not disclose the substrate and frame member made of resin (re claim 21), conductors made from layers of noble metal (re claim 25).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use resin for the substrate and frame member or to use noble metal for the conductor of of Daniels et al, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

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Allowable Subject Matter

5. Claims 8-15, 20 are allowed.
6. The following is an examiner's statement of reasons for allowance:

The limitation "roughened surface" in combination with other limitations present is neither taught nor disclosed in the prior art of record.

Response to Arguments

Applicant's arguments filed have been fully considered but they are not persuasive.

Applicant argues (1) that the cover member does not completely fill the cavity member in the manner illustrated in Maekawa (re claim 1). The examiner disagrees. It is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung V. Ngo whose telephone number is (703) 308-7614. The examiner can normally be reached on Tuesday to Friday from 8:30 am to 06:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard, can be reached on (703) 308-3682.

The fax phone number for this Group is (703) 305-3431 or (703) 305-3432.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Hung V. Ngo

Hung V. Ngo

HUNG V. NGO
PATENT EXAMINER

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November 15, 2002